

AMENDMENTS TO THE DRAWINGS

Please replace the drawings with the attached nine (9) replacement sheets of drawings, containing Figures 1-7(d).

### REMARKS

In this amendment, Applicant has amended the abstract to comply with the 150 word limit set forth in 37 C.F.R. 1.72. Applicant is also submitting herewith revised drawing sheets 1-9 which address the Examiner's objection to the use of handwritten numerals.

With respect to the claims, Applicant has amended Claim 2 to address the Examiner's objections by amending the phrase "the a handlebar" to read "a handlebar." Claim 5 has also been amended to further recite that the claimed adjusting piston adjustably extends into the master chamber. New Claim 16 has also been added. Claim 16 depends from Claim 2 and further recites that the master cylinder assembly comprises a main chamber for the master piston and an adjuster chamber for the adjusting piston. It further recites that the master piston and adjusting piston are each adjustable to vary their respective depths within their respective chambers and that the depths of the master piston and the adjusting piston in their respective chambers define a volume of hydraulic fluid in the master cylinder assembly.

No claims have been deleted. Thus, Claims 2-5, 7, 10 and 16 remain pending. The foregoing amendments are supported by the originally-filed application, and no new matter has been added.

Rejection of Claims 2 and 5 Under 35 U.S.C. § 103(a)

In the previous Office Action, the Examiner allowed Claims 2-5, 7 and 10. However, the Examiner has now rejected these previously allowed claims.

According to the Examiner, Claims 2 and 5 are obvious over the combination of Nagano, U.S. Patent No. 5,325,735 ("Nagano") and Wendler, U.S. Patent No. 5,890,979. Wendler was previously asserted. While Nagano is newly asserted, it is no more pertinent than Ose, U.S. Patent No. 5,676,022, over which Claims 2 and 5 were previously deemed allowable. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 2 recites an adjusting piston adjustably extending into a master cylinder assembly. As with the earlier combination of Ose and Wendler, Nagano and Wendler do not disclose this feature of Claim 2. According to the Examiner, Wendler's reference numeral 15 is an "adjusting piston." Applicant respectfully disagrees. As Wendler clearly states, reference numeral 15 is an "air bleed screw." Wendler at 6:33. First, one of ordinary skill in the art would readily appreciate that an air bleed screw is not a piston. Second, nothing in Wendler's disclosure suggests that the screw adjustably extends into the master cylinder assembly, as recited in Applicant's Claim 2. Thus, Nagano and Wendler cannot be combined to obtain the claimed invention.

Claim 5 depends from Claim 2 and further recites that the master cylinder assembly comprises a main chamber for the

master piston, an adjuster chamber for the adjusting piston, and that the adjusting piston adjustably extends into the adjuster chamber. Wendler does not depict the air bleed screw 15 extending into any chamber, let alone an adjuster chamber as claimed. Thus, Claim 5 recites additional patentable features that further distinguish the references of record.

New Claim 16 depends from Claim 2 and further recites that the adjusting piston is adjustable to vary the depth of the adjusting piston in the master chamber. It also recites that the depth of the master piston in the master chamber and the depth of the adjusting piston in the adjuster chamber define a volume of hydraulic fluid in the master cylinder assembly. Given that they do not even disclose an adjusting piston, Wendler and Nagano cannot be combined to obtain the subject matter of Claim 16.

Notwithstanding the foregoing, the Examiner has not identified a motivation or suggestion in the prior art for combining Wendler and Nagano *and modifying them* in the manner necessary to obtain the subject matter of Claims 2, 5 and 16. "When prior art references require selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d 1132 (Fed. Cir. 1985). Claim 2 recites a rotating member that is rotatable about a pivot shaft which is spaced apart from a handlebar. Wendler does not disclose a rotating member as

claimed. Neither reference provides any suggestion as to how to operatively connect the claimed rotating member to a master piston, as is also recited in the claim. Therefore, to obtain the claimed invention, the references would have to be selectively modified in a manner that is not suggested by either reference. "The mere fact that prior art *could* be modified in the manner proposed by the Examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification." Ex parte Dussaud, 7 USPQ2d 1818, 1820 (Bd. App. & Int'l 1988) (emphasis added); see also In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989). Accordingly, the rejection should be withdrawn.

Rejection of Claims 3 and 4 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 3 and 4 as obvious under 35 U.S.C. § 103(a) over the combination of Nagano, Wendler, and Kund, U.S. Patent No. 5,178,033 ("Kund"). Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 3 depends from Claim 2 and recites further details concerning the claimed push mechanism and return mechanism. Claim 4 depends from Claim 3 and recites a pinion gear operatively connected to the rotating member and a rack gear engaged with the pinion gear and operatively connected to the master piston.

Kund is directed to a bicycle gear display. The Examiner relies on Kund for its disclosure of a rack and pinion

assembly in Figure 7. At the outset, it should be noted that Claim 3 does not recite a rack gear or a pinion gear, and it should not be interpreted as including such limitations.

Kund does not compensate for the deficiencies of Nagano and Wendler. Thus, for the reasons provided above with respect to Claim 2, the combined references do not include all of the limitations of Claim 3 or Claim 4. Therefore, they cannot render the claims obvious. Moreover, Claim 4 recites an operative connection between a pinion gear and the claimed rotating member, as well as a rack gear engaged with the pinion gear and operatively connected to the master piston. Kund does not suggest or disclose any means for modifying Nagano and Wendler to use a rack and pinion gear having the claimed operative connections to a rotating member and master piston. Because the Examiner has not identified a motivation or suggestion in the prior art for modifying the references in the manner required to obtain the claimed invention, the rejection should be withdrawn. See Ex parte Dussaud, 7 USPQ2d 1818, 1820 (Bd. App. & Int'l 1988); see also In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

Rejection of Claims 7 and 10 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 7 and 10 as obvious under 35 U.S.C. § 103(a) over the combination of Nagano, Wendler and Kund. Claim 7 recites a shift control device comprising, *inter alia*, an adjusting piston adjustably extending into a

master cylinder assembly. As mentioned previously, neither Nagano, Wendler nor Kund disclose this feature. Thus, the references of record cannot be combined to obtain the claimed invention, and therefore, do not render it obvious. Claim 10 recites a shift control device comprising, *inter alia*, an adjuster piston threadingly engaged with a master cylinder assembly and operable to adjust the volume of the conduit. For the reasons provided above, Wendler's air bleed screw 15 does not meet these limitations. Thus, the references cannot be combined to obtain the claimed invention.

In addition, the Examiner has failed to identify a suggestion or motivation in the prior art for combining and modifying Nagano, Wendler, and Kund in the manner necessary to obtain the inventions described in Claims 7 and 10. Like Claim 4, Claim 7 recites a pinion gear operatively connected to a rotating member, as well as a rack gear that is engaged with the pinion gear and operatively connected to a master piston. While Kund discloses the use of a rack and pinion gear assembly generally, it does not disclose how to provide the claimed operative connections between a rack and pinion gear assembly and a rotating member and master piston. Nor do Wendler and Nagano. Thus, there is no motivation or suggestion in the prior art for modifying the references in the manner necessary to obtain the claimed invention.

Similarly, Claim 10 recites a neutrally biased control lever that actuates a positioning mechanism having a rotating

member. The rotating member is operatively connected to a master cylinder assembly having a primary piston. Notwithstanding the Examiner's contention that Nagano discloses a neutrally biased lever which rotates a rotating member, Nagano does not disclose or suggest connecting a rotating member to a master cylinder assembly or how to do it. Nor does Wendler. Thus, the references do not disclose the modifications necessary to obtain the claimed invention, and the rejection should be withdrawn.


CONCLUSION

Accordingly, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that there are any further issues which require resolution, she is invited to contact the Applicant's attorney at the number below.

Respectfully submitted,

JEFFER, MANGELS, BUTLER & MARMARO LLP

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By:   
\_\_\_\_\_  
Steven R. Hansen, Esq.  
Reg. No. 39,214  
1900 Avenue of the Stars  
Seventh Floor  
Los Angeles, CA 90067-4308  
(310) 203-8080